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Could  
(c) a plurality of traction members extending from the opposing bottom surface of said flange, said flange distributing said weight over turf being walked on while said traction members provide traction against said turf; and

(d) said flange and said traction members having a combined profile of at most about 0.25 inch as measured from said upper surface of said flange to a bottom portion of a most downwardly extending portion of said traction members;

wherein said cleat provides traction against the ground without doing damage to the turf surface being walked on and without puncturing golf turf. - -

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#### REMARKS

Claim 27 has been amended to correct two inadvertent errors in which the "traction members" recited in section (c) were later incorrectly referred to as "traction means". Claims 18 - 34 are presented for reconsideration.

#### The Rejections Under 35 U.S.C. §112

Claims 18-26 stand rejected under 35 U.S.C. §112, first paragraph, as containing subject matter not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the invention at the time the application was filed. Specifically, the phrase "traction means" is deemed by the Examiner to be new matter. These same claims also stand rejected under 35 U.S.C. §112, second paragraph, as being vague and indefinite because the equivalents of the disclosed ribs, covered by the recited "traction means", are not characterized. These rejections are traversed for the reasons stated below.

First, it must be noted that claim 26 has apparently been included in this rejection by error. The phrase "traction means" does not appear in claim 26.

Second, the comments set forth in the Preliminary Amendment on this issue, at pages 7 - 10, are incorporated by reference and hereby repeated to preserve those arguments for Appeal.

Third, it is submitted, as to the rejection based on §112, first paragraph, it is important to note that neither the Examiner nor the BPAI has cited any case law or other precedent in support of the unique theory employed in this rejection. On the contrary, the case law and precedent cited herein and cited previously by Applicants are clearly contrary to the Examiner's position.

It is well established that broadening a claim during prosecution does not add new matter to the disclosure, and that, as long as the claims read on the disclosure, an applicant is entitled to claims as broad as the prior art and his disclosure will allow. See *In re Rasmussen*, 211 USPQ 323, 325 (CCPA 1981). Further, citing *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 227 USPQ 177, 179 (Fed. Cir. 1985), the Federal Circuit stated, in *Utter v. Hiraga*, 6 USPQ2d 1709, (CAFC 1988) that: "A specification may, within the meaning of 35 U.S.C. §112 ¶1, contain a written description of a broadly claimed invention without describing all species that claim encompasses." As noted in Applicants' Preliminary Amendment, the CAFC, in *Texas Instruments, Inc. v. U.S. Int'l Trade Comm'n*, 231 USPQ 833, 839 (Fed. Cir. 1986) held that an ALJ erred in limiting the structure corresponding to means-plus-function claim limitations to the embodiment disclosed in the specification because the statute, **§112-6, was written precisely to avoid a holding that a means-plus-function limitation must be read as covering only the specific means disclosed in the specification.**

The meaning of "equivalents" is well understood in patent law, and an applicant need not describe in the specification the full range of equivalents (or, for that matter, any equivalents) of the invention, some of which may be nonexistent at the time the application is filed. See *In re Noll*, 191 USPQ 721, 727 (CCPA 1976). If, as expressly required by the statute, a means-plus-function limitation is to be interpreted as covering "the corresponding structure..... described in the specification and equivalents thereof" (emphasis added), then, by definition, the equivalents are something not described *in haec verba* in the specification. *Noll*, 191 USPQ at 727 (noting that section 112, sixth paragraph, equivalents "may be nonexistent at the time the application is filed"); see also *Texas Instruments, Inc. v. U.S. Int'l Trade Commission*, *supra*. If a preferred embodiment is described in the specification, and other embodiments are also described, those other embodiments are in fact "corresponding structures," under §112-

6; any other undescribed, structures are the statutorily defined "equivalents thereof". *Noll*, 191 USPQ at 727. The Examiner's position would, in effect, render the "equivalents thereof" language in the statute meaningless, and that has long been recognized as impermissible statutory construction. *United States v. Menasche*, 349 U.S. 528, 538-39 (1955) ("It is our duty to give effect, if possible, to every clause and every word of a statute."); *Platt v. Union Pacific R.R.*, 99 U.S. 48, 58 (1876) ("But the admitted rules of statutory construction declare that a legislature is presumed to have used no superfluous words. Courts are to accord a meaning, if possible, to every word in a statute."); See also: *In re Finch*, 190 USPQ 64, 65 (CCPA 1976); and *In re Barker and Pehl*, 194 USPQ 470 (CCPA 1977). **In other words, the Examiner, in misinterpreting §112-1 to effectively read "equivalents thereof" out of §112-6, is proceeding directly contrary to the dictates of the U.S. Supreme Court and the CCPA, the predecessor court of the Federal Circuit.**

The M.P.E.P. is entirely consistent with the foregoing statements. Specifically, M.P.E.P. section 2184 states as follows:

"To interpret the 'means plus function' limitation as limited to a particular means set forth in the specification would nullify the provisions of 35 U.S.C. 112 requiring that the limitation shall be construed to cover the structure described in the specification and equivalents thereof." (emphasis in original),

citing *D.M.I., Inc. v. Deere & Co.*, 225 USPQ 236, 238 (Fed. Cir. 1985). Moreover, M.P.E.P. section 2182, citing the *Noll* case, states:

"The specification need not describe the equivalents of the structures, material, or acts corresponding to the means- (or step-) plus-function claim element".

Against all of this authority and precedent, and other authority and precedent cited in the Preliminary Amendment, the Examiner cites not a single case or other item of authority. This is not surprising, since the concept underlying the rejection is so contrary to U.S. patent practice as to be shocking. The USPTO and patent practitioners

have long understood that a "means-plus-function" claim, whether filed as part of the original application or added during prosecution, is permissible, provided that it reads on the disclosed embodiment(s) and is not anticipated by prior art. Disclosure of only a single limited embodiment of a claim element supports any added "means plus function" recitation as long as the "function" is performed by that disclosed embodiment.

Applying the foregoing to the present case, the Examiner states that Applicants introduced new matter by introducing means-plus-function claims covering undescribed equivalents. However, if (as by definition must be the case) one need not describe the equivalents, then means-plus-function claims always define undescribed subject matter. The statute expressly permits such claims, and makes no distinction as to when they may be presented during prosecution. Therefore, such claims cannot be rejected under 35 U.S.C. §112, first paragraph, as not being supported, as long they read on one disclosed embodiment

Accordingly, it is submitted that the rejection under 35 U.S.C. §112, first paragraph, is improper and should be withdrawn.

Fourth, as to the rejection under the second paragraph of §112, again there is no precedent cited in support of the Examiner's position. The Examiner argues that, because the equivalents covered by the means-plus-function claims are not disclosed, the scope of the claim is indefinite. This is contrary to the requirements of M.P.E.P. section 2181 wherein, citing the *Noll* case, it is stated:

"[u]nless the means-plus-function language is itself unclear, a claim limitation written in means-plus-function language meets the definiteness requirement in 35 U.S.C. 112, second paragraph so long as the specification meets the written description requirement in 35 U.S.C. 112, first paragraph."

The Examiner is not alleging that the disclosure of Applicants' ridges does not meet the written description requirement in 35 U.S.C. §112, first paragraph. Further, there is no issue regarding the definiteness of the means-plus-function language *per se*. Therefore, the means-plus-function language must, according to the M.P.E.P., meet the definiteness requirement in 35 U.S.C. §112, second paragraph

As Applicant has previously noted, the CCPA has explicitly reversed a rejection on the these very grounds in *In re Noll*, (191 USPQ at 727). Moreover, as noted above, equivalents, by definition, are never disclosed. Therefore, such claims cannot be rejected as indefinite if there is at least one corresponding structure clearly described in the specification. *Atmel Corp. v. Information Storage Devices, Inc.*, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999) ("All one needs to do in order to obtain the benefit of that claiming device [§112, sixth paragraph] is to recite some structure corresponding to the means in the specification, as the statute states, so that one can readily ascertain what the claim means and comply with the particularity requirement of [§112,] ¶ 2.").

For all of these reasons, claims 18-26 are in compliance with 35 U.S.C. §112, first and second paragraphs, and are therefore patentable.

#### The Rejection Under 35 U.S.C. §102(b)

Claims 18-20, 22, 26-30 and 34 stand rejected under 35 U.S.C. §102 (b) as being anticipated by Jordan (3583082). This rejection is respectfully traversed.

Initially, the arguments set forth in the Preliminary Amendment on this issue, at pages 10 -13, are incorporated by reference and hereby repeated to preserve those arguments for Appeal.

It must be noted that this rejection is in conflict with the position taken by the Examiner in the rejection under 35 U.S.C. §112, first paragraph. The §112-1 rejection is based on the position that there are no disclosed equivalents for the "traction means" recited in, for example, claim 18. Therefore, according to the Examiner, claim 18 adds new matter. This must be viewed in connection with the fact that the Federal Circuit has clearly charged the USPTO, when searching prior art for correspondence to a "means plus function" recitation, with the responsibility of considering §112-6 to determine whether or not prior art falls within the scope of the statutory equivalents of the recited means. See *In re Donaldson*, 29 USPQ2d 1845, 1848-1849 (Fed. Cir. 1994). This requirement is stated in section 2182 of the M.P.E.P. Thus, if the Examiner is, as she must be, following the dictates of the M.P.E.P. and the *Donaldson* case, the Examiner, at least tacitly, considers the Jordan traction elements to be included within the scope of equivalents of the claimed "traction means", since clearly the ridges disclosed by

Applicants are not identical to the bristles 18 disclosed by Jordan. That being the case, for purposes of the §102 rejection, the bristles must be deemed by the Examiner to be "equivalents" of the ridges. However, if Applicants' ridges have any "equivalents" whatsoever, then the Examiner's rationale for the §112-1 rejection based on new matter, whether supported by authority or not, cannot stand. "Equivalents" cannot be construed in opposite ways to serve different purposes. If the Examiner continues to maintain both the §102 rejection and the two §112 rejections, it is respectfully requested that the Examiner clarify this inconsistency in order to permit Applicants to efficiently address the issues on appeal.

Apart from the inconsistency, the rejected independent claims 18, 26, 27 and 34 define a removable cleat in which a flange contacts "turf" being walked on and distributes weight over the "turf", while traction means or protrusions from the flange provide traction against the "turf", all without damaging or puncturing the "turf". The Examiner's statement that the flange in Jordan is capable of bearing weight, depending on the surface, ignores the fact that Applicant's claims require the weight to be distributed over turf. "Turf" is defined as "the upper stratum of soil bound by grass and plant roots into a thick mat" in the Merriam-Webster Collegiate Dictionary (On-Line Version); and as "a surface layer of earth containing a dense growth of grass and its matted roots" in The American Heritage Dictionary of the English Language, Houghton Mifflin Company, 1992 edition. The Examiner's position takes both the claimed structure and the cited Jordan structure out of their respective operating environments and place them in a nonsensical environment. Would the flange in the Jordan structure bear weight in sand? Jordan is silent on this issue; but in any case, that issue is irrelevant because the claims require the flange to be weight-bearing on turf. If the Examiner is reading the "turf" limitation out of the claims, as would appear to be the case, such "reading out" is not justified. Words relating to a "claim environment" must be given patentable weight where those words "are necessary to give meaning to the claim and properly define the invention". *Perkin-Elmer Corp. v. Computervision Corp.*, 221 USPQ 669, 675 (Fed. Cir. 1989). Applicants are claiming a golf cleat and its operation on turf. The "turf" is not only necessary to give meaning to the claim, it is critical to the claim and the proper definition of the invention. Accordingly, how the

Jordan spike may function in sand is irrelevant, both because the claims require the flange to distribute weight on "turf", and because Jordan does not disclose use of his spike in a sand environment or how the spike would function if used in a sand environment.

The only descriptions of "use" in the Jordan patent indicate that the bristles must be stiff enough to support a wearer's weight and strong enough to maintain substantially the same attitude during use (Jordan, at column 2, lines 25-29). This is the only teaching in Jordan regarding supporting the wearer's weight. The only supporting of weight performed by Jordan's "flange" as disclosed is the indirect support resulting from the transmission of force longitudinally through the bristles to the flange. Jordan has no disclosure whatsoever that the "flange" contacts the track on which it is used (much less turf) to support weight as required by the rejected claims. Certainly, there is no discussion of how the bristles or flange function on granular terrain, such as sand.

Jordan has absolutely no disclosure regarding use on turf because Jordan is designed for running on cinder tracks. Moreover, one would not normally describe the effect of Jordan's bristles on grass or turf as "indenting"; although Jordan uses the term "indenting," the "indenting" that Jordan describes, when translated from hard cinder tracks to grass, must be viewed as "puncturing" within the context applicants' claim. Stated otherwise, it is impossible for the Jordan cleat to provide traction without puncturing and damaging turf.

As discussed above, the only reasonable reading of Jordan is that the weight of a wearer is borne solely by the bristles, and that the weight of a wearer standing on turf would be transmitted fully through bristles. If the Jordan cleats were used on turf, then, the Jordan bristles cannot help but penetrate at least to the soil, whereby at least some of the bristles must puncture the crowns of grass plants, because as they bear the wearer's full weight, the bristles must keep going, penetrating whatever is in their path, until the soil stops them. Further, even if the Jordan spike were used on sand, as suggested by the Examiner, the bristles would also penetrate through the sand, as would any spike or cleat. Clearly, this is contrary to the intended function of the Jordan spike. (As an aside, is the Examiner seriously contending that any rational person would wear cleats that are intended for providing traction on firm surfaces on a sandy or

other granular surface)? If the Examiner disagrees with Applicant's position, it is respectfully requested that the Examiner explain how the unyielding bristles of Jordan, which "must be of sufficient stiffness so that they will not collapse or break off when supporting the weight on an athlete", can possibly not either (1) penetrate turf and thereby damage the turf or (2) support the weight of the wearer above the turf and thereby prevent the flange from supporting the weight of the wearer. Such explanation is necessary to permit applicants to properly respond to the rejection.

It is well established that anticipation under §102 requires the presence, in a single prior art reference, of disclosure of each and every element of the claimed invention. See *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al.*, 221 USPQ 481, 485 (CA FC 1984), citing *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193 (Fed. Cir. 1983); and *SSIH Equip. S.A. v. USITC*, 218 USPQ 678 (Fed. Cir. 1983). The absence of any teaching in Jordan of the claimed operation of Applicants' cleat on "turf" precludes any anticipation by Jordan of Applicants' claims.

In view of the foregoing, independent claims 18, 26, 27 and 34 are not anticipated by Jordan.

Claims 19, 20, 22, and 28 – 30 depend from the respective ones of these independent claims and are patentable therewith. In addition, claims 19 and 28 require that the traction means/members be made of resilient material; Jordan's bristles are described only as stiff with no suggestion of resiliency. As noted above, a rejection under 35 U.S.C. §102 requires that every feature of a claim be disclosed in a single reference. Accordingly, the rejection of claims 19 and 28 is improper apart from the distinguishing features of their parent independent claims.

#### The Rejections Under 35 U.S.C. §103(a)

Claim 21 stands rejected under 35 U.S.C. §103(a) as unpatentable over Jordan. Claims 25 and 33 stand rejected under 35 U.S.C. §103(a) as unpatentable over Jordan in view of Zaleski (2491596). These rejections are respectfully traversed. Both rejections rely on the misinterpretation of the Jordan disclosure discussed above in connection with the section §102 rejection. Nothing stated in the rejections of these



claims, and nothing disclosed by Zaleski, rectifies the deficiencies of the Jordan patent as a reference.

### The Double Patenting Rejections

The Examiner has rejected claims 18 – 34 under the judicially created doctrine of double patenting over claims 1 – 13 of U.S. Patent No. 6354021. The Examiner has also rejected claims 18 – 34 under the judicially created doctrine of double patenting over claims 1 – 10 of U.S. Patent No. 5259129. In stating the grounds for these rejections, the Examiner states that the '021 and '129 patents and the present application claim, *inter alia*, "traction means". This statement is made in spite of the fact that the Examiner has refused to permit Applicants to include "traction means" in the claims of the subject application on the grounds that "traction means" constitutes new matter and that "traction means" is vague and indefinite. Thus, in stating this rejection the Examiner is effectively saying that Applicants can recite "traction means" in the claims of the subject application, but in stating the §112 rejections the Examiner is refusing to permit Applicants to recite "traction means". Applicants stand willing to submit appropriate Terminal Disclaimers once the basis for the double patenting rejections are understood; however, the basis for the rejections is unclear in view of the conflicting interpretations of "traction means" employed in the Office Action.

### Conclusion

For the reasons set forth above, Applicants respectfully submit that this application, as amended, is in condition for allowance. An early and favorable action is respectfully requested.

Respectfully submitted,



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## APPENDIX

### Version of Amendments to Claim 27 with Markings to Show Changes Made

27 (Amended). A removable golf shoe cleat for use in a golf shoe having a sole, said sole having a plurality of cleat receiving members for attachment of respective removable cleats, said removable golf shoe cleat comprising:

(a) a flange having an upper surface and an opposing bottom surface that distributes the weight of the wearer of said cleat over turf being walked on;

(b) a flange attachment member extending from said upper surface of said flange for removably attaching said cleat to one of said cleat receiving members of said sole of said shoe; and

(c) a plurality of traction members extending from the opposing bottom surface of said flange, said flange distributing said weight over turf being walked on while said traction members provide traction against said turf; and

(d) said flange and said traction [means] members having a combined profile of at most about 0.25 inch as measured from said upper surface of said flange to a bottom portion of a most downwardly extending portion of said traction [means] members;

wherein said cleat provides traction against the ground without doing damage to the turf surface being walked on and without puncturing golf turf.